

REMARKS

Status of the Claims

Claims 1-4, 7-22, 25-33, 48 and 49 are pending in this application. Claims 1, 18 and 28 are amended. Claims 34-47 have been canceled as being drawn to a non-elected invention pursuant to the Restriction Requirement. Claims 1 and 18 are in independent form. Claims 5, 6, 23 and 24 are canceled without prejudice or disclaimer of the subject matter contained therein. Claims 48-63 are added.

Rejection of Claims 1, 4, 7-11, 13, 16-18, 21, 22, 25-27, 29, 32 and 33 Under 35 U.S.C. § 102

The Office action rejects Claims 1, 4, 7-11, 13, 16-18, 21, 22, 25-27, 29, 32 and 33 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 4,971,726 to Maeno (hereinafter "Maeno"). The rejection is respectfully traversed.

By this Amendment, independent Claims 1 and 18 are amended to include the feature of a separator plate having a first surface and a second surface, wherein at least some of the expanded graphite or compressible material extends from the first surface to the second surface. This feature was substantially recited in dependent Claims 6 and 24.

In addition, Claims 1 and 18 are amended to remove the feature of a separator plate wherein the expanded graphite or compressible material is in particle sizes greater than 10% of the final plate thickness, which was indicated as allowable subject matter in the previous Office action and is now recited in new dependent Claims 48 and 49.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. See MPEP §2131.

Contrary to the Office action that all of the elements of Claims 1 and 18 are disclosed in Maeno, at least the feature of a separator plate having a first surface and a second surface, wherein at

least some of the expanded graphite or compressible material extends from the first surface to the second surface, is not disclosed, taught or suggested in Maeno, so the rejection is unsupported by the art and should be withdrawn.

For at least this reason, independent Claims 1 and 18 are allowable over the applied art. Claims 4, 7-11, 13, 16 and 17, which depend from Claim 1, and Claims 21, 22, 25-27, 29, 32 and 33, which depend from Claim 18, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 2, 3, 19 and 20 Under 35 U.S.C. § 103

The Office action rejects Claims 2, 3, 19 and 20 under 35 U.S.C. §103(a) over Maeno in view of U.S. Published Application 2002/0182473 to Blunk et al. (hereinafter "Blunk '473"). The rejection is respectfully traversed.

According to MPEP §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

It is respectfully submitted that the Office action fails to establish a *prima facie* case of obviousness because at least one of the three criteria have *not* been met. Specifically, the combination of Maeno and Blunk '473 does *not* disclose, teach or suggest all the claim limitations, as recited in amended independent Claims 1 and 18. Specifically, there is no mention in Maeno or Blunk '473 of at least the feature of a separator plate having a first surface

and a second surface, wherein at least some of the expanded graphite or compressible material extends from the first surface to the second surface, as recited in amended independent Claims 1 and 18. Thus, the Office action fails to establish a *prima facie* case of obviousness.

For at least this reason, Claims 1 and 18 are allowable over the applied art, taken singly or in combination. Claims 2, 3, which depend from Claim 1, and Claims 19 and 20, which depend from Claim 18, are likewise allowable over the applied art, taken singly or in combination. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 6, 14, 15, 24, 30 and 31 Under 35 U.S.C. § 103

The Office action rejects Claims 6, 14, 15, 24, 30 and 31 under 35 U.S.C. §103(a) over Maeno in view of U.S. Patent No. 6,811,918 to Blunk et al. (hereinafter "Blunk '918"). The rejection is respectfully traversed.

It is respectfully submitted that the Blunk '918 is disqualified as prior art under 35 U.S.C. §103(c). The present application has a filing date of June 26, 2003 and was assigned to General Motors Corporation on November 24, 2003 at Reel/Frame 014722/0438. Evidence of such an assignment is attached hereto. Blunk '918 issued on November 2, 2004 and was assigned to General Motors Corporation on January 29, 2002 at Reel/Frame 012549/0986. Evidence of such an assignment is attached hereto. Thus, the present invention and Blunk '918 are commonly owned, and the Blunk '918 patent is disqualified as prior art under 35 U.S.C. §103(c).

For at least this reason, Claims 6, 14, 15, 24, 30 and 31 are allowable over the applied art, taken singly or in combination. Withdrawal of the rejection is respectfully requested.

New independent Claim 50 specifies, *inter alia*, a separator plate including the feature of a layer of conductive material disposed over said first surface, said layer of conductive material in contact with said compressible conductive material. It is respectfully submitted that at least

this feature is not disclosed, taught or suggested in the applied art, taken singly or in combination.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited.

Should Examiner Cantelmo believe anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 07-0960 (General Motors Corporation). A duplicate copy of this sheet is enclosed.

Respectfully submitted,


by _____
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